

REMARKS

Claims 1-21 are currently pending in the application. Reconsideration of the rejected claims in view of the following remarks is respectfully requested.

Allowed Claims

Applicants appreciate the indication that claims 2, 3, 11-16, 20 and 21 contain allowable subject matter and would be allowable if rewritten to include all the features of the rejected base claim and intervening claims. However, Applicants submit that all of the claims are in condition for allowance for the following reasons.

35 U.S.C. §103 Rejection

Claims 1, 4-10 and 17-19 were rejected under 35 U.S.C. §103(a) for being unpatentable over non-patent document by Shobaki *et al* ("Shobaki") in view of U.S. Patent Publication No. 20030056154A1 to Edwards *et al.* ("Edwards"). Applicants submit that the rejection of claims 1, 4-10, and 17-19 are rendered moot in view of the submitted Declaration under 37 C.F.R. §1.131, by the named inventors.

More specifically, Applicants submit that the Rule 131 Declaration is formally and substantively sufficient to establish that the Inventors had completed the invention defined in at least independent claims 1, 17 and 19 before the effective dates of the primary reference to Shobaki, i.e., March 26, 2001. The statements in the Declaration show that the formal requirements of §1.131 are satisfied, namely:

- (1) the rejections to be overcome are under §103(a),
- (2) all the acts for completing the invention of claims 1, 17 and 19 were performed in this country, and

(3) the effective date of the Shobaki reference, i.e., March 26, 2001, is not more than one year prior to the filing date of the present application in this country.

It is respectfully submitted that the statements in the Declaration are also sufficient to satisfy the substantive requirements of 37 C.F.R. §1.131. The Declaration sets forth specific facts, of sufficient character and weight, to establish a **date of conception** before the effective dates of the Shobaki reference of March 26, 2001, and to show that the Inventors and their attorneys exercised **due diligence** from a time before the effective filing date of the Shobaki primary reference to a constructive reduction to practice, i.e., to the filing of the application.

Date of Conception

As stated in the Declaration, an on-chip logic analysis system including a single chip device including a signal processing unit and a host unit externally provided as disclosed and recited in claims 1, 17 and 19 of the application (and those claims dependent thereon) was conceived by the Inventors before the effective date of the Shobaki reference. An IBM Invention Disclosure is submitted with the Declaration as supporting evidence of this prior date of conception. It is respectfully submitted that the Invention Disclosure shows that the Inventors had a definite and permanent idea of the complete and operative invention of claims 1, 17 and 19, as presently pending, prior to the March 26, 2001 effective date of the Shobaki reference. The supporting documents also show the prior date of conception.

In particular, the Invention Disclosure shows, textually and pictorially, the features of claims 1, 17 and 19. In fact, these Figures are the basis for several of the figures filed in the application and used for support for the pending claims. The supporting documents also show that the features of claims 1, 17 and 19 were conceived prior to the effective date of the Shobaki reference, i.e., March 26, 2001. Also, Applicants note that the original copy of the Invention

Disclosure shows a date antedating the March 26, 2001 effective date of the Shobaki reference. This and all other pertinent dates have been removed from the photocopies of the Invention Disclosure submitted with the Declaration to prevent any potential prejudice to Applicants. It is noted that the figures provided above are illustrative in nature and are not intended as limiting features of the invention.

Applicants further submit that the Declaration filed herewith shows, unequivocally, that the Inventors had in their possession a definite and permanent idea of the complete and operative invention of claims 1, 17 and 19 before March 26, 2001 in a manner sufficient to satisfy the requirements of conception, as set forth in M.P.E.P. §§ 715.07 and 2138.04, and thus constitute *prima facie* evidence of Applicants' date of conception of the invention in this country before the effective date of the Shobaki reference.

Due Diligence

Applicants further submit that the Declaration shows the Inventors and their attorneys exercised due diligence from a time before the March 26, 2001 effective date of the Shobaki reference to a constructive reduction to practice, realized by the filing of the above-identified patent application on November 16, 2001. The IBM Invention Disclosure was completed by the Inventors and forwarded to IBM internal counsel prior to the Shobaki reference date of March 26, 2001. IBM authorized outside counsel at the undersigned firm to prepare the application, and supplied the Invention Disclosure to outside counsel in a timely manner. Numerous discussions between the Inventors and counsel took place until a first draft of the application was forwarded to Inventor, Steve Parker. Revisions were made and subsequent drafts were prepared and reviewed by the Inventors, until a final draft was forwarded to IBM for execution on November 13, 2001, and subsequent filing on November 16, 2001.

Outside patent counsel also acted in an expeditious manner to prepare and forward the application to filing. Under M.P.E.P. § 2138.06, only ***reasonable*** diligence is required in this

regard. More specifically, § 2138.06 states that a patent attorney will be held to have exercised reasonable diligence if the attorney worked reasonably hard on the application during the critical period, taking into consideration any backlog of unrelated cases the attorney may have had and his completion of those cases along with the present application in chronological order.

Applicants respectfully submit that the Declaration shows that their patent attorneys acted sufficiently expeditiously to satisfy the requirements of due diligence. Applicants submit that the Declaration submitted herewith are sufficient to show that the Inventors and their attorneys exercised due diligence the due diligence required under 37 C.F.R. § 131. The Declarations show that at least one Inventor remained in regular contact with patent attorneys to answer questions, provide technical explanation, and supply the supplemental disclosure materials necessary for enabling the application to be filed in an expeditious manner.

CONCLUSION

Applicants believe that a full and complete response has been made to the pending Office Action and respectfully submit that all of the stated objections and grounds for rejection have been overcome or rendered moot. Applicant submits that all of the claims are allowable and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Prompt and favorable consideration of this reply is respectfully requested.

Respectfully submitted,



Andrew M. Calderon
Registration No. 38,093

Charles J. Gross
Registration No. 52, 972

January 21, 2004
McGuireWoods, LLP
Suite 1800
1750 Tysons Blvd.
McLean, VA 22102
(703) 712-5341